Office-Supreme Court, U.S.
FILED
APR 6 1962
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961.

No. 803

HARRY P. LOCKLIN AND ELMER J. BRANT, GENERAL PARTNERS DOING BUSINESS UNDER THE FIRM NAME OF RADIANT COLOR COMPANY,

Petitioners,

vs.

SWITZER BROTHERS, INC., A CORPORATION,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION.

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COUNTERSTATEMENT OF QUESTION PRESENTED FOR REVIEW.

Where an Appellate Court finds complete compliance of a patent with the express provisions of a statute, and wherein the statute has caused no confusion in the courts, should certiorari be granted to determine a moot question as to whether that statute supersedes previous decisions of this Court from which the Appellate Court clearly distinguished in finding such compliance?

ARGUMENT.

Petitioner has presented as the sole question for review one that unfairly represents as facts exactly the opposite of what the courts below found to be the facts. The concurrent findings of fact below are that the use of the functional language in the claims resulted in no indefiniteness; that such language restricted, rather than broadened, the scope of the claims; and that:

> "When the general description, the specific examples, and the claims are read together, the invention is so plainly defined that no one skilled in the art should have any difficulty in practicing it." (App. viii.)*

The courts below thus found complete compliance of the claims with the provisions of Section 112. Petitioner seeks to show non-compliance by reference, not to the statute, but by reference to earlier cases of this Court that are clearly inapposite and from which both of the lower courts distinguished.

Petitioner is asking (p. 9) that this Court determine whether Section 112 of the Patent Act of 1952 liberalizes or renders obsolete the rule in the *G. E. v. Wabash*** and the *Halliburton*** cases. The answer is immaterial to the outcome of this case since the Appellate Court followed the express wording of Section 112 and also clearly distinguished from those cases and others on which petitioner relied. Whether this Court holds that the rules laid down

* App. is the abbreviation used to indicate the Appendices to the Petition.

** *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364.

** *Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1.

in those cases have been abolished, or merely modified or distinguished by Section 112 is immaterial; the outcome would be the same—a decision in favor of respondent. Petitioner does not challenge the constitutionality of Section 112, nor here assert that the Appellate Court did not follow the Statute.

Realizing that it has not presented a question of sufficient public interest to warrant the grant of its petition, petitioner falls back on wholly irrelevant cases (p. 10), in which this Court granted certiorari because of the concentration of the industry affected in a single circuit, and the consequent improbability of a conflict of decisions arising between different circuits. Petitioner has admitted (p. 9) that contrary facts exist here by its reference to the suit in the Seventh Circuit brought by respondent against Lawter Chemicals, Inc. That suit was settled out of court and accordingly was dismissed on April 11, 1961 *without prejudice* as to the same patent that is here in suit (768 O. G. 280). Petitioner's allegation (p. 10) that "Absolute exclusion of the public is established by the decision below * * * until October 1974" is therefore refuted by petitioner's own admission that Lawter is still active in another circuit in this same field of making pigment resins for fluorescent paints.

The question presented by petitioner for review assumes indefiniteness because of functional language used in the claim and implies that if any testing is required to determine the actual scope of the claims, that, in and of itself, establishes indefiniteness.

The third paragraph of Section 112, however, specifically states that: "An element in a claim for a combination may be expressed as a means or step for performing a specified function * * *". This provision is itself justification for language in the claims, reading:

> "* * * the amount of said melamine compound being an amount, not exceeding 50% by weight of the aromatic monosulfonamide, sufficient to render said condensation product substantially insoluble in aromatic hydrocarbon solvents but insufficient to render it thermosetting."

Petitioner does not distinguish between function in terms of properties or qualities, and function in terms of performance in intended end use. Yet the cases on which petitioner relies all fall in the second category. Such functionality is objectionable because it renders the claims so broad, vague and or indefinite as to cover the desired end result, purpose or aim of the invention without reciting sufficient structure or instrumentalities for effecting the function.

The claims here in suit fall in the first category. The amount of melamine is specified as being an amount, not exceeding 50% by weight of the aromatic monosulfonamide component, that is sufficient to give the resin the property of being "substantially insoluble in aromatic hydrocarbon solvents," but that is insufficient to impart to the resin the property of being thermosetting. Only simple, routine tests are required to determine whether the resin has these properties. They are not tests of the resin in end use performance but as the Appellate Court found (App. viii), are tests of physical properties that are "for an ordinary chemist to perform," not requiring "extensive experimentation."

These very tests as to insolubility and thermosetting properties were routinely made and reported by petitioner's expert, Mr. Paulsen, months before trial (DX. A, R. 335, 872; and DX. B, R. 838, 874). With the knowledge of the results of such routine tests, petitioner, using language identical with that of the claims, admitted as to its resins (R. 525):

> "With respect to the resins which Radiant Color

> Company uses in its pigments, we will admit on the record that the resin is thermoplastic and that it is a co-condensation product having formaldehyde, toluene-sulfonamide and melamine components.
>
> "In addition, we will admit that the amount of melamine component exceeds 25% but does not exceed 50% by weight of the sulfonamide component, and that the amount of melamine component is sufficient to render the condensation product substantially insoluble in aromatic hydrocarbon solvents, but that it is insufficient to render it thermosetting."

It was on the basis of the testimony as to these reports (DX. A and DX. B) that the Appellate Court found (App. viii):

> "There is testimony to the effect that 'sufficient melamine to render the resin substantially insoluble' is a simple, clear test for an ordinary chemist to perform and one which does not require extensive experimentation in order that the precise critical limits be ascertained in a particular case."

Clearly, this Court should "not disturb concurrent findings where, as here, there is evidence to support them." *Williams Manufacturing Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 367.

The Reasons Alleged for Granting the Writ Are Ill-Founded.

Here, there is no conflict with the decision of this Court in *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364. The courts below, after full consideration of every argument advanced by petitioner here, held otherwise (as epitomized at App. viii).

As to the decision in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1, petitioner admits (pp. 8-9) that the later enacted Section 112 is in conflict with the *Halliburton* rule, but quotes with apparent approval the com-

mentator's notes, 35 U. S. C. A. p. 25, stating that such decisions as the *Halliburton* decision "are modified or rendered obsolete."

The lower courts in this case have already given the proper interpretation to the claims in suit and have found such claims to comply with Section 112. This Court has repeatedly denied petitions for the writ of certiorari based upon this very Section 112.

All of the decisions of this Court on which petitioner relies were rendered prior to the enactment of Section 112. In those cases arising since enactment of Section 112, where functionality at the exact point of novelty has been urged as rendering the claims in suit invalid, both Circuit and District Courts have distinguished from *General Electric v. Wabash Appliance*, 304 U. S. 364, as for instance:

(1) *Aluminum Company of America et al. v. Sperry Products, Inc. et al.*, 285 F. 2d 911; cert. den. 368 U. S. 890, in which the following question was presented:

"Has Section 112 of the 1952 Patent Act (35 U. S. C. 112):

(a) so 'modified or rendered obsolete' the prior existing decisions of this Court holding functional patent claims invalid, that claims relying solely upon a functional statement for their novelty are now valid?",

in support of which were cited, among others, the cases of *General Electric Company v. Wabash*, 304 U. S. 364, 371, *United Carbon Co. v. Binney Co.*, 317 U. S. 228, 234 and *Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1, 9.

(2) *Upjohn Company v. Italian Drug Importing Co., Inc.* (D. C. S. D. N. Y. 1961), 190 F. Supp. 361 (not appealed).

In the latter case, the District Court pointed out, as respondent did below, that the *G. E. v. Wabash* case specifically approves "a limited use of terms of effect or result, which accurately define the essential qualities of a product to one skilled in the art * * *." That is what the functional language in the claims here in suit does.

The qualities or properties possessed by the patented resin of being thermoplastic rather than thermosetting, and of being substantially insoluble in aromatic hydrocarbon solvents are not ultimate functions expressed in terms of performance in end use. Instead, they are benchmarks, just as would be a designated melting point. That such insolubility is not determinative of its sole utility, as was the function "to prevent substantial sagging and offsetting" in the claims of the *G. E.* case, is evident from the District Court's observation (R. 125), based upon Example 15 of the patent in suit, that the patented resin "is soluble in ketones * * * to form coating compositions." Such utility in no way stems from its claimed quality of aromatic hydrocarbon insolubility.

Here, petitioner contends that bench marks in a claim, upon which may be predicated routine tests, well known in the art, represent fatal functionality. This specious argument was rejected by the Appellate Court (App. viii) on the authority of *Minerals Separation, Limited v. Hyde*, 1916, 242 U. S. 261, in which, at page 271, this Court held:

> "The composition of ores varies infinitely, each one presenting its special problem, and it is obviously impossible to specify in a patent the precise treatment which would be most successful and economical in each case. The process is one for dealing with a large class of substances and the range of treatment within the terms of the claims, while leaving something to the skill of persons applying the invention, is clearly sufficiently definite to guide those skilled in the art to its successful application, as the evidence abundantly shows. This satisfies the law."

The analogy of the above holding to the present case is obvious. There, the amount of oil to be used was specified as "amounting to a fraction of one percent on the ore." As here, no numerical lower limit was specified, and no exact numerical percentage was given for each type of ore, so that "when different ores are treated, preliminary tests must be made to determine the amount of oil and extent of agitation necessary in order to obtain best results" (p. 270). So, here, with different melamine components, preliminary tests may be necessary to determine the lower limits of the melamine component needed to give aromatic hydrocarbon insolubility. With melamine itself, the lower limits of melamine are those in Examples 2 and 5 of the Kazenas patent, as found by both the District Court (R. 138) and the Appellate Court (App. viii). Thus, with melamine, itself, no experimentation whatsoever is necessary to determine the lower limit. Petitioner uses melamine, itself (R. 572). The claims are specific to melamine, as well as to other melamine components, because of their ex parte Markush form.

CONCLUSION.

Petitioner raises no question of public interest. The Court of Appeals, in deciding legal questions involved, followed Section 112 of the 1952 Patent Act.

The Petition should be denied.

Respectfully submitted.

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